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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,483	09/27/2001	Robert A. Koch	BS01-080	8720
38516	7590	10/28/2005	EXAMINER	
SCOTT P. ZIMMERMAN, PLLC			WON, MICHAEL YOUNG	
PO BOX 3822			ART UNIT	
CARY, NC 27519			PAPER NUMBER	
			2155	

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)	
09/963,483	KOCH ET AL	
Examiner	Art Unit	
Michael Y. Won	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,12-14,16,17,19,21,22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,12-14,16,17,19,21,22 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the Request for Continued Examination and the Amendment filed on September 21, 2005.
2. Claims 1, 12, 14, and 16 have been amended.
3. Claims 1, 2, 4-6, 12-14, 16, 17, 19, 21, 22, and 24 have been examined and are pending with this action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 12 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Duphorne (US 6,212,265 B1).

As per ***claim 12***, Duphorne teaches a method for delivering a notification of an email arrival to a shared broadband appliance, said method comprising: receiving a

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message on an application server, said message including at least an email addressee (see col.1, lines 19-21 and col.3, lines 60-63); looking up the email addressee in a database to identify an internet protocol address and a user name associated with the email addressee (see col.4, lines 32-47), the internet protocol address associated with the shared broadband appliance (see col.9, lines 14-19); and sending an instruction from the application server to the shared broadband appliance based on the internet protocol address (see col.4, lines 8-13), said instruction including at least the user name and directing the broadband appliance to display a notice directed to the user name (see col.4, lines 24-31 & 35-47).

As per **claim 13**, Duphorne further teaches wherein the message further includes a sender email address and the instruction further directing the broadband appliance to display the sender address (see col.8, lines 28-33).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4-6, 14, 16, 17, 19, 21, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duphorne (US 6,212,265 B1) in view of Brachman et al. (US 6,374,102 B1).

INDEPENDENT:

As per **claim 1**, Duphorne teaches a method for delivering a distinctive notification of an email arrival to a telephone customer premises equipment, said method comprising:

receiving a message on an application server, said message including at least an email addressee (see col.1, lines 19-21 and col.3, lines 60-63);

looking up the email addressee in a database to identify at least a subscriber directory number associated with the email addressee (see col.10, line 52 to col.11, line 2);

retrieving a distinctive ring tone (see col.10, lines 15-24);

sending an instruction from the application server (see col.4, lines 8-13), said instruction including at least the subscriber directory number (see col.10, lines 58-62) and a distinctive ring tone (see col.10, lines 15-24);

causing a network node to initiate a call to the subscriber directory number (see col.10, line 66 to col.11, line 2); and

sending a signal to the telephone customer premises equipment (see col.2, lines 38-42 and col.11, lines 2-14) to provide the distinctive notification to the email addressee of the email arrival (see col.4, line 44 and col.10, lines 15-24).

Duphorne does not explicitly teach wherein the ring tone is selected by the email addressee from multiple ring tones associated with the directory number, to provide a distinct notification despite different email addresses associated with the directory number. Brachman teaches of a ring tone that is selectable from multiple ring tones

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associated with the directory number, to provide a distinct notification (see col.75, lines 9-52).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Brachman within the method of Duphorne by implementing a distinctive ring tone selectable from multiple ring tones associated with a directory number to provide a distinct notification within the method for delivering a distinctive notification of an email arrival to a telephone customer premises equipment because similar to distinguishing different ring tones for many directory numbers (see Brachman: col.7, lines 45-50), such an implementation allows customers to distinguish among a plurality of email addresses since most customers have more than one email address (personal email and work email).

As per **claim 14**, Duphorne teaches a method for delivering a distinctive notification of an email arrival to a telephone customer premises equipment, said method comprising:

receiving a message on an application server, said message including at least an email addressee (see col.1, lines 19-21 and col.3, lines 60-63);

looking up the email addressee in a database to identify at least a subscriber directory number associated with the email addressee (see col.10, line 52 to col.11, line 2);

retrieving a distinctive ring tone (see col.10, lines 15-24);

sending an instruction, said instruction including at least the subscriber directory number (see col.10, lines 58-62) and the distinctive ring tone (see col.10, lines 15-24), from the application server to a network node capable of initiating a telephone call (see col.4, lines 8-13); and

causing the network node to initiate the telephone call to the subscriber directory number (see col.10, line 66 to col.11, line 2).

Duphorne does not explicitly teach wherein the distinctive ring tone is selected by the email addressee from multiple ring tones associated with the subscriber directory number, to provide a distinct notification despite different email addresses associated with the subscriber directory number. Brachman teaches of a ring tone that is selectable from multiple ring tones associated with the subscriber directory number, to provide a distinct notification (see col.75, lines 9-52).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Brachman within the method of Duphorne by implementing a distinctive ring tone selectable from multiple ring tones associated with a subscriber directory number to provide a distinct notification within the method for delivering a distinctive notification of an email arrival to a telephone customer premises equipment because similar to distinguishing different ring tones for many directory numbers (see Brachman: col.7, lines 45-50), such an implementation allows customers to distinguish among a plurality of email addresses since most customers have more than one email address (personal email and work email).

As per **claim 19**, Duphorne teaches a system for delivering a distinctive notification of an email arrival, said system comprising:

a server receiving a message, the message including at least an email addressee (see col.1, lines 19-21 and col.3, lines 60-63);

a database looking up the email addressee to identify a subscriber directory number and a distinctive ring tone (see col.10, lines 15-24) associated with the email addressee (see col.10, line 52 to col.11, line 2); and

a network node receiving the subscriber directory number in an instruction to initiate a call to the subscriber directory number (see col.10, line 66 to col.11, line 2), wherein the call provides the distinctive notification (see col.4, line 44 and col.10, lines 15-24) of the arrival of the email (see col.2, lines 38-42 and col.11, lines 2-14).

Duphorne does not explicitly teach wherein the distinctive ring tone is selected by the email addressee from multiple ring tones associated with the subscriber directory number, to provide a distinct notification despite different email addresses associated with the subscriber directory number. Brachman teaches of a ring tone that is selectable from multiple ring tones associated with the subscriber directory number, to provide a distinct notification (see col.75, lines 9-52).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Brachman within the system of Duphorne by implementing a distinctive ring tone selectable from multiple ring tones associated with a subscriber directory number to provide a distinct notification within the method for delivering a distinctive notification of an email arrival because similar to

distinguishing different ring tones for many directory numbers (see Brachman: col.7, lines 45-50), such an implementation allows customers to distinguish among a plurality of email addresses since most customers have more than one email address (personal email and work email).

DEPENDENT:

As per **claim 2**, Duphorne further teaches wherein the telephone customer premises equipment comprises a telephone device (see col.7, lines 20-22).

As per **claim 4**, Duphorne further teaches wherein the telephone customer premises equipment comprises a caller-id display device (see Fig.1, #20 and col.3, lines 48-59).

As per **claims 5 and 21**, Duphorne further teaches wherein the signal or the instruction comprises a text message for display on the caller-id display device (see col.3, lines 48-59).

As per **claims 6, 17 and 22**, Duphorne further teaches wherein the step of looking up the email addressee in a database further comprises identifying a user name associated with the email addressee (see col.4, lines 35-47).

As per claim 16, Duphorne further teaches wherein sending the instruction comprises sending a code indicating the distinctive ring tone for the call.

As per **claim 24**, Duphorne teaches of further comprising a mail server receiving the email (see col.2, lines 21-24).

Response to Arguments

6. Applicant's arguments with respect to claims 12 and 13 have been fully considered but they are not persuasive. *Duphorne* clearly teaches the claimed limitation of "the internet protocol address associated with the shared broadband appliance". Not only is such limitation inherent since *Duphorne* teaches throughout the specification of transmitting a "CallerID-compatible email notification signal" to the user's "notification device 20" (see col.4, lines 20-24; col.6, lines 15-18; and col.9, lines 10-25), but *Duphorne* explicitly teaches of "whose Internet address is stored... of the user notification database 14c" (see col.9, lines 14-19). Clearly, without the address of the broadband appliance, the email notification signal would either not be delivered or delivered to the wrong address which clearly teaches away from *Duphorne's* teaching of transmitting a "CallerID-compatible email notification signal" to the user's "notification device 20".

7. In response to applicant's argument regarding claims 1, 14, and 19, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some *teaching, suggestion, or motivation* to do so found *either* in the references themselves or in the *knowledge generally available to one of ordinary skill in the art*. See *In re Fine*, 837 F.2d 1071, 5

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USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, it is not uncommon for email users to have more than two email addresses. Such knowledge is generally available and known to one of ordinary skill in the art. By incorporating the teachings of Brachman within the system of Duphorne, it allows customers to incorporate multiple email addresses and gives the user the ability to distinguish the email reception among a plurality of email addresses, which ultimately gives the customer greater control and flexibility.

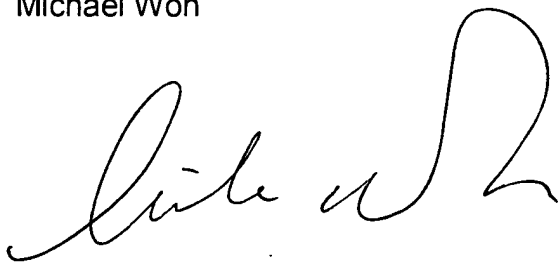
8. For the reasons above claims 1, 2, 4-6, 12-14, 16, 17, 19, 21, 22, and 24 have been rejected and remain pending.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

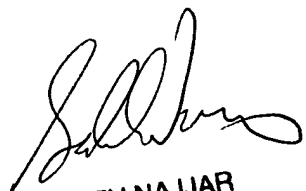
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Won



October 24, 2005



SALEH NAJJAR
SUPERVISORY PATENT EXAMINER